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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,819	03/23/2001	Kurt Kemper	112791.1100	8216

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EXAMINER

ECHOLS, PERCY W

ART UNIT	PAPER NUMBER
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3726

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,819

Applicant(s)

KEMPER ET AL.

Examiner

P. W. Echols

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The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-62 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

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1. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

2. The disclosure is objected to because of the following informalities: There are references to the claims on pages 2-16 of the specification. The references to the claims should be removed..

Appropriate correction is required.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-62 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims require exposing the treated surfaces to inherent compressive stresses and exposing zones beneath the treated surfaces to inherent tensile stresses axially and tangentially (see claim 1, lines 4-7 or claim 19, lines 3-6, for example). There is no disclosure of how these stresses are provided and there is no disclosure of what the tensile stresses are axial and tangential to. The examiner does not understand the disclosure. Is the invention work hardening the work? Is it burnishing the work or is it doing something else?

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 1-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are replete with indefinite language too numerous to identify specifically.

a) Claim 1, lines 4-7; claims 19, 20 and 37, lines 3-6; there is no disclosure of "inherent stresses" and there is no disclosure of what the tensile stresses are axial or tangential to..

b) Claim 3, line 2, the phrase "at least one, or two" is unclear as to how many rolls the claim is limited to.

c) Claim 5, line 2, "or similar opening" is indefinite because there is no disclosure of what is required to be "similar".

d) Claim 7, last two lines, the phrase, "a lead position substantially opposing each other" is not understood. How can a lead position oppose each other?

e) Claim 13, line 4, the phrase, "or similar supporting means" is not defined in the specification. There is no description of what is required to be similar.

f) Claim 17, line 4, "more particularly" is objected to as being indefinite because it is unclear what the bounds of the claim are.

g) Claim 27, line 3, it is unclear what diameter is smaller than.

h) Claim 48, line 2, "said at least one further roll" lacks proper antecedent.

i) Claim 51, line 5, "said smooth incoming end and said smooth outgoing end" lack proper antecedent.

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j) Claim 59, line 3, the use of "especially" is indefinite as it leaves the bounds of the claim unclear.

It is emphasized that the above rejections are only exemplary and not complete. The claims should be thoroughly reviewed for compliance with both the first and second paragraphs of 35 USC 112.

7. A statement on patentability cannot be made at this time in view of the examiner's lack of understanding of the disclosure and claims. Should the claims be amended so that an art rejection can be made that rejection may be made final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. W. Echols whose telephone number is 703-308-1802. The examiner can normally be reached on M-F 9-5:30..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1802.

P. W. Echols
Primary Examiner
Art Unit 3726



pwe
February 10, 2003